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SAN FRANCISCO, CA 94111-3834

In re Application of:

TANAKA ET AL.

Serial No.: 10/652,653

Filed: August 28, 2003

Title: SAN/NAS INTEGRATED STORAGE  
SYSTEM

DECISION ON PETITION TO  
MAKE SPECIAL UNDER 37  
C.F.R. § 1.102(d)

This is a decision on the petition filed on November 24, 2004, to make the above-identified application special under the accelerated examination procedure set forth in MPEP § 708.02(VIII) in accordance with 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

In support of the petition, petition provides: a) the applicable petition fee; b) a statement that all claims are directed to a single invention; c) a statement that a pre-examination search was made, including the search areas; d) a copy of each of the references deemed most closely related to the claimed subject matter; and e) a detailed discussion of the references pointing out how the claimed subject matter is distinguishable over the references.

For accelerated examination under MPEP § 708.02(VIII) in accordance with 37 C.F.R. § 1.102(d), a showing of the following is required: a) a petition to make special accompanied by the applicable petition fee; b) all claims are directed to a single invention; c) a statement that a pre-examination search was made, including the search areas; d) a copy of each of the references deemed most closely related to the claimed subject matter; and e) a detailed discussion of the references pointing out with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is distinguishable over the references.

The requirements of MPEP § 708.02(VIII)(a) – (d) are considered to have been met. However, petitioner fails to point out with the particularity required by 37 CFR § 1.111 (b) and (c), how the claimed subject matter is distinguishable over the references. Therefore, petitioner fails to meet the requirement of MPEP § 708.02(VIII)(e).

37 CFR § 1.111 (b) states "[a] general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." 37 CFR § 1.111 (c) states in part "the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made."


Applicant presents a summary of the limitations of the independent claims (pages 3-4), a statement that none of the references disclose the storage system having combination of limitations found in the independent claims (pages 4-5), and a list of each of the cited references along with a short summary of the teachings of each reference (pages 5-9).

Petitioner fails to distinguish each independent claim from each reference in a manner satisfying 37 CFR § 1.111 (b) and (c). For instance, with respect to submitted reference number 5, petitioner does not state what limitations the claims recite which are neither disclosed nor made obvious by the reference. Such a statement is required under 37 CFR § 1.111 (b) and (c). A mere summary of the claims and the references, with no comparison and distinguishment between the two, is insufficient to satisfy the requirements of MPEP § 708.02(VIII)(e).

For the above-mentioned reasons, the petition is denied. The application will therefore be taken up by the examiner for action in its regular turn.

Any request for reconsideration of this decision must be submitted within 2 (two) months of the date of this decision in order to be considered timely.

Any inquiry regarding this decision should be directed to Clayton E. LaBalle, Special Program Examiner, at (571) 272-1594.

  
Clayton E. LaBalle, Special Programs Examiner  
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